REMARKS/ARGUMENTS

These remarks are submitted responsive to the final office action dated January 05, 2005 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraph 12 of the Office Action, claims 1-5, 8-25, and 28-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Application No. 2001/0042083 to Saito, *et al.* (Saito) in view of U.S. Published Application No. 2002/0054090 to Silva, *et al.* (Silva). In paragraph 13 of the Office Action, claims 6-7 and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito in view of Silva, in further view of U.S. Patent No. 6,732,102 to Khandekar (Khandekar).

Applicants wish to thank the Examiner for a thorough review of the present application and for taking the time to participate in a conference regarding the present Office Action on February 17, 2005. As an initial matter, Applicants believe the final rejection was asserted prematurely.

According to MPEP 706.07(a) an office action can be made final in a second or subsequent action except where the Examiner introduces a new ground of rejection that is neither necessitated by the Applicants' amendment of the claims nor based upon information submitted in an information disclosure statement (IDS). As noted by paragraph 14 of the Office Action, new grounds for rejection have been introduced.

Applicants assert that the new grounds were not necessitated by a prior claim amendment. To review, below is an excerpt from the Applicants' previous response detailing the claim amendments that were made in that response:

> *In response to the Office Action, Applicants have amended claims 1 and 22 to clarify that each template is associated with a target markup language, as noted at page 18, lines 7-10 at page 20, lines 19-21, at page 23, lines 5-11, and throughout the specification. Claims 8-11 and 28-31 have been*

amended for grammatical reasons resulting from the amendments to claims 1 and 22.

Claim 13 has been amended in a similar fashion as claim 1 to indicate that templates are associated with both a document and a target markup language different from the markup language of the document. Support for this amendment is detailed above (the same as the support for amendments to claims 1 and 22).

Claim 14 has been amended in a fashion similar to claims 1, 13, and 22. Claims 17-21 have been amended for grammatical reasons resulting from the amendments to claim 14. No new matter has been added as a result of these amendments.

Applicants note that these amendments were made to correct the syntax of the previously asserted claims to overcome the previously asserted 35 U.S.C. § 112 objection stating that the phrase "a different markup language" was indefinite, since no other "markup" language was previously mentioned. The amendment was consistent with the Examiners' interpretation of the claims' meaning (referring again to the § 112 objection requiring that the Examiner review the application after making a reasonable interpretation of the claim believed to be indefinite). The amendments did not alter the scope of the claims nor otherwise necessitate the new grounds for rejection.

As an aside, the references of Patel, Fox and Cuomo upon which the prior grounds for rejection were asserted were not referenced in the Office Action. Applicants previously asserted a Declarations Under 37 C.F.R. § 1.131 to remove the Patel and Fox references as having an effective date after the Applicants' priority date and provided arguments under 35 U.S.C. § 103(c) to remove the Cuomo reference. None of these three references nor grounds associated with them are asserted within the present Office Action.

Accordingly, it appears as if the new grounds for rejection were not necessitated by a previous amendment. Based upon the above considerations that seem to indicate that the new grounds of rejection were not necessitated by prior claim amendments, Applicants respectfully request that the finality of the present Office Action be removed.

Again, Applicants would like to thank the Examiner for his time during the telephone conference of February 17, 2005. During this conference, Applicants discussed with the Examiner their previously submitted Declarations under 37 C.F.R. § 1.131 (the "Declarations"). In paragraph 15 of the present Office Action, the Examiner has indicated the confidential invention disclosure section previously referenced was not within the file to which he had access. The lack of this document was apparently due to Applicants' submitting the Declarations and attached Confidential Invention Disclosure in a separate envelope marked "Confidential - Not for Scanning Into the Public Record", resulting in the aforementioned documents not being scanned into the digital records at the USPTO. To overcome this difficulty, Applicants faxed a copy of the Confidential Invention Disclosure directly to the Examiner together with proof of receipt regarding the same from the USPTO on February 17, 2005.

The disposition of the previously submitted Declarations is of import at present since the same previously submitted Declarations also indicate an effective date of Applicants' invention which predates the Saito reference. Accordingly, acceptance of the previously submitted Declarations would result in the removal of the current rejections and would place the Application in a condition for allowance. After briefly reviewing the faxed Confidential Invention Disclosure and the previously submitted Declarations, the Examiner verbally indicated that conception appeared sufficient for purposes of the Declarations, but that further evidence of diligence would be helpful in prosecuting the present Application.

In response, Applicants re-assert the previously submitted Declarations supporting the removal of Silva as a reference. The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-1999-0119 (the "Disclosure") entitled "Method and Apparatus to Parse Generic HTML Data for Voice Presentation and User Interaction." The Disclosure demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as November 11, 1999, which predates the effective date of Silva of September 1, 2000.

As to conception, Applicants are required to provide (from MPEP 715) facts showing a completion of the invention commensurate with the extent of the invention as claimed. In proving conception, Applicants can show that the differences between the claimed invention and the showing under 37 CFR § 1.131 would have been obvious to one of ordinary skill in the art. Such evidence is sufficient because Applicant's possession of what is shown carries with it possession of variations and adaptations, which would have been obvious, at the same time, to one of ordinary skill in the art. Facts to be used in support of a 37 CFR § 1.131 Declaration (from MPEP 715.07) can include supporting statements by witnesses (MPEP 715.07 (G)) and disclosure documents (MPEP 715.07(H)).

The Disclosure is completion of an IBM confidential disclosure form, which is a standardized document utilized by the International Business Machines Corporation (IBM) and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure, once the Disclosure has been completed. Any changes and/or additions are appended to an attachment to the IBM confidential disclosure form along with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since November 11, 1999.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present Application including each claim within the present Application has been prepared based upon the Disclosure. Further, as noted in the enclosed Declarations, prior to submission of the application to the United States Patent and Trademark Office (USPTO), the inventors reviewed the Application to insure that the claims and material contained therein were fully supported by the Disclosure. The above facts are certified to be true to the knowledge of the undersigned and have been sworn to by the inventors in paragraphs 2-5 of the submitted Declarations.

Additionally, in the Application claims are fully supported by the Disclosure that includes:

> **"The solution uses a table lookup mechanism that has contained within it, the structure of web pages being referenced. For example, the Yahoo movie pages have the theater name at byte offset 57 for 35 bytes, and repeating fields for the movies playing at by 235 for 600 bytes (for example). So rather than parsing the page to "flip" one set of tags to another and keep the data in place and in a coupled together interface, there would be a table lookup for the page layout (like a Lotus Notes template) and the data can be extracted and placed into Voice (or other) oriented markup specific to the application."**

An inventive aspect of the Disclosure readily apparent to one of ordinary skill in the art pertains to automatically extracting data from a Web page encoded in one format (the data can be extracted from the in-place data within the Web site) for presentation in a targeted medium or interface in another format ("and placed into oriented markup specific to the application"). Accordingly, the Applicants have claimed (claim 1) a method for converting formatted content comprising identifying a template which corresponds to a specified document and a target markup language, said specified document including said

formatted content that is formatted using a markup language; applying said template to said specified document, an application extracting data from said formatted content; and formatting said data based upon the template; wherein formatting produces a second document formatted for the target markup language. This claimed method, as well as all other claims within the present application, fall within the scope of the Disclosure for purposes of conception (i.e. Applicants' possession of what is shown *in the Disclosure* carries with it possession of variations and adaptations, which would have been obvious, at the same time, to one of ordinary skill in the art.)

Applicants further exercised due diligence from prior to the effective date of Silva to March 6, 2001, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the Application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the Application sufficiently details the inventive concepts detailed in the Disclosure, at which time the Application is expeditiously filed with the USPTO. The above facts are certified to be true to the knowledge of the undersigned and have been sworn by the inventors in paragraphs 2-5 of the submitted Declarations.

As to the period between September 1, 2000 and March 06, 2001, this was a time period in which outside counsel spent drafting the present application and iteratively reviewing and revising the drafted application with the inventors until it was finalized in its submitted form. This activity (*reasonable time spent drafting and reviewing a patent application*) is believed to fall within the legal requirements for a showing of diligence

under MPEP 715.07(a). As to proof of this activity, Applicants refer the Examiner to the following documents:

1. May 11, 2000 document entitled "6169-143 Misc" evidencing attorney notes taken during telephone conference with inventors regarding invention;
2. November 15, 2000 letter to inventor concerning the first submitted draft of the present application for inventor review;
3. February 1, 2001 fax transmission page indicating correspondence between the patent attorney and the lead inventor regarding the draft application;
4. February 15, 2001 fax transmittal page indicating correspondence between the patent attorney and the lead inventor (forwarding a revised draft with formal documents for signing);
5. February 22, 2001 letter to an inventor for review of the application and signing of formal documents;
6. February 27, 2001 letter to an inventor for review of the application and signing of formal documents; and
7. Paragraphs 4 and 5 of the sworn and notarized declarations provided by the inventors.

In light of the above, Applicants have shown that the present invention was conceived before the effective date of Silva and that legally sufficient diligence was exercised in constructively reducing the invention to practice at least in regard to the critical time period between just prior to the effective date of Silva until the filing date was exercised. Accordingly, Silva should be withdrawn as a reference for purposes of 35 U.S.C. § 103(a), which action is respectfully requested. Withdrawal of Silva as a reference should result in a withdrawal of the rejections with respect to claims 1-32, which action is respectfully requested.

Applicants note that in the absence of Silva, the Examiner has acknowledged the claimed invention includes limitations not explicitly or implicitly included in other cited art references. Applicants refer the Examiner back to the previous office action response for detailed remarks distinguishing the presently claimed invention over the teachings of the principle reference (Saito).

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: 18 March 2005

Gregory A. Nelson, Registration No. 30,577
Richard A. Hinson, Registration No. 47,652
Brian K. Buchheit, Registration No. 52,667
AKERMAN SENTERFITT
Customer No. 40987
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000

"6169-143 Misc" document reflects notes taken by attorney in consultation with lead inventor and typed May 11, 2000.

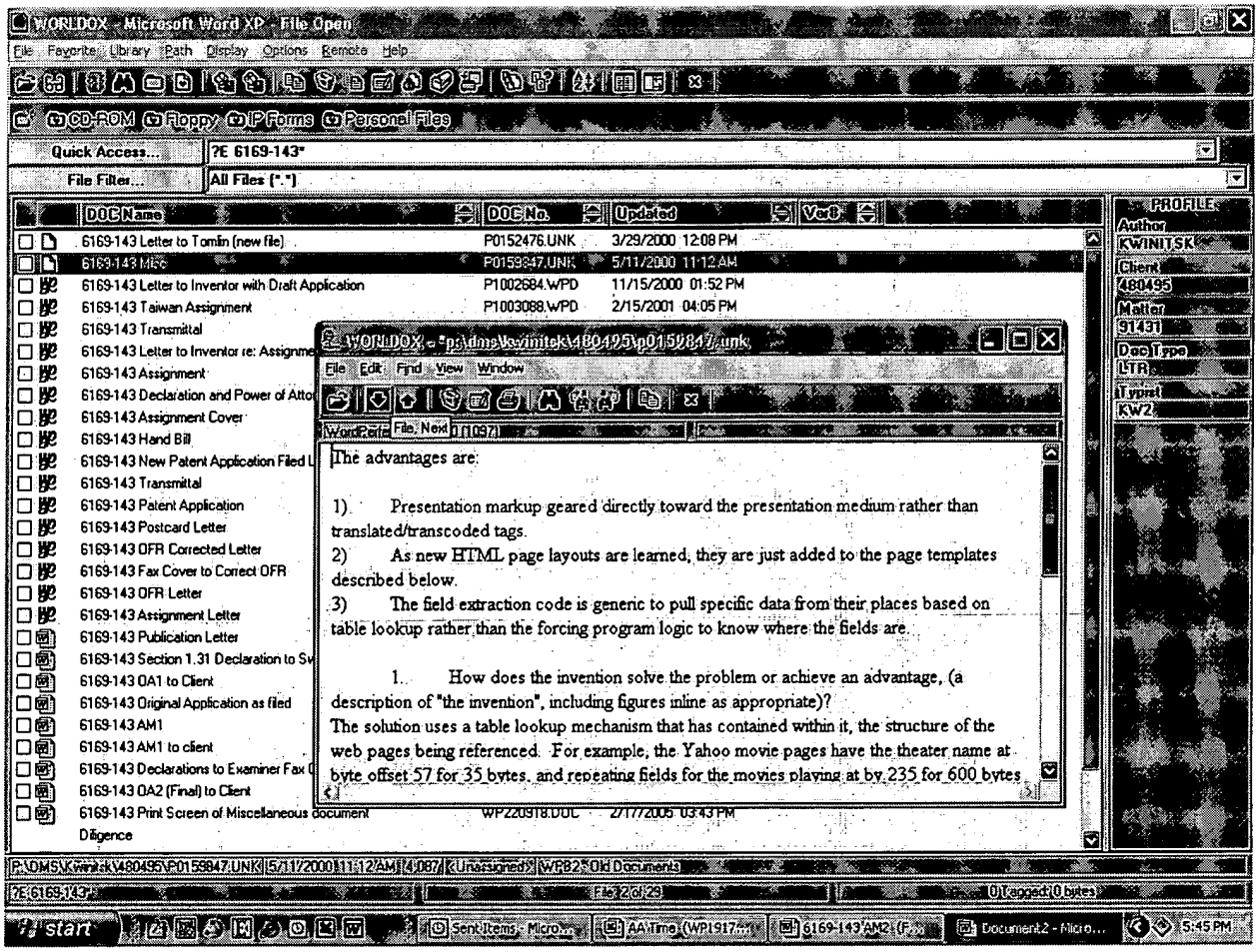
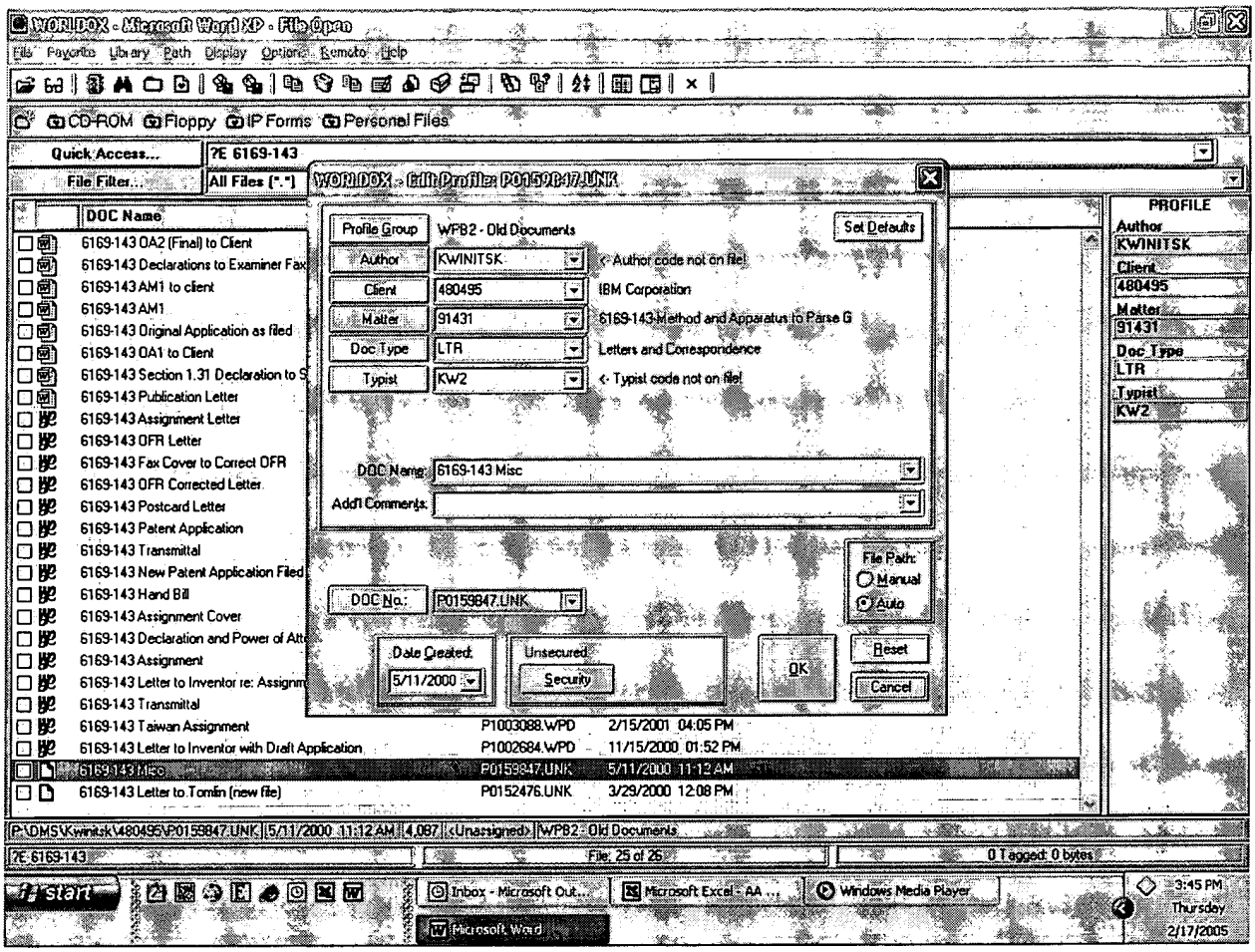


EXHIBIT 1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CD-ROM Floppy IP Forms Personal Files
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WORLDOX - Edit Profile: P0159847.UNK
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6169-143 OA2 (Final) to Client
6169-143 Declarations to Examiner Fax
6169-143 AM1 to client
6169-143 AM1
6169-143 Original Application as filed
6169-143 OA1 to Client
6169-143 Section 1.31 Declaration to S
6169-143 Publication Letter
6169-143 Assignment Letter
6169-143 OFR Letter
6169-143 Fax Cover to Correct OFR
6169-143 OFR Corrected Letter
6169-143 Postcard Letter
6169-143 Patent Application
6169-143 Transmittal
6169-143 New Patent Application Filed
6169-143 Hand Bill
6169-143 Assignment Cover
6169-143 Declaration and Power of Att
6169-143 Assignment
6169-143 Letter to Inventor re: Assignm
6169-143 Transmittal
6169-143 Taiwan Assignment
6169-143 Letter to Inventor with Draft Application
6169-143 Misc
6169-143 Letter to Tomlin (new file)
Profile Group
WPB2 - Old Documents
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<- Author code not on file!
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480495
IBM Corporation
Matter
91431
6169-143 Method and Apparatus to Parse G
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6169-143 Misc
Addtl Comments:
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P1002684.WPD 11/15/2000 01:52 PM
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Microsoft Excel - AA ...
Windows Media Player
Microsoft Word
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Thursday
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November 15, 2000

VIA FACSIMILE 561-615-7005

Mr. David E. Reich
IBM Corporation
1555 Palm Beach Lakes Blvd.
6th Floor
West Palm Beach, FL 33401

Re: New Patent Application
METHOD AND APPARATUS FOR REFORMATTING FORMATTED CONTENT
IBM Docket No. BOC9-1999-0090; Our Ref: 6169-143

Dear David:

Enclosed please find a draft of a patent application for the above-identified matter. Please review it carefully to ensure that the description of the invention accurately recites all of the invention's characteristics in the broadest possible manner, while also explaining, in detail, the preferred embodiment of the invention. The drawings should also be reviewed to confirm that they accurately depict the various details of the invention as you understand them. Finally, please read through the numbered claims at the end of the application. The claims will define the scope of protection any patent issuing from this application will provide. Accordingly, you should review them to ensure that they do not unduly restrict the scope of the invention by including any unnecessary detail. Once you have reviewed the application, please forward it to the other inventors for their review as well. Please call me with any comments you may have.

EXHIBIT 2

Please recall that patent applicants have a duty to disclose to the United States Patent Office all reasonably pertinent prior art of which they are aware. Failure to do so can jeopardize the validity of any patent issuing from an application. Accordingly, should you become aware of such references at any time during the pendency of this application, please let us know.

Very truly yours,

AKERMAN SENTERFITT

Steven M. Greenberg

SMG/kmw
Enclosure

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PLEASE DELIVER THE ACCOMPANYING TELECOPIED MATERIAL TO:	**TRANSMITTAL DATE:** Nov 15, 2000
NAME: Mr. David E. Reich	**CLIENT/MATTER NO:** 6169-143
PHONE:	**TOTAL PAGES:** 36
FIRM/COMPANY NAME: IBM Corporation	**CITY, STATE:**

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SENDER'S NAME: Steven M. Greenberg

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EXHIBIT 3

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FAX: 615-7005

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SENDER'S NAME: Kathleen

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** TX STATUS REPORT ** AS OF FEB 15 2001 16:57 PAGE.01

AKERMAN SENTERFITT

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http://www.akerman.com

Equitrac User ID:

FAX: 615-7005

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NAME: David Reich	**CLIENT/MATTER NO:** 6169-143
PHONE:	**TOTAL PAGES:** 41
FIRM/COMPANY NAME:	**CITY, STATE:**

SENDER'S NAME: Kevin Cuenot

Comments from Sender:

Enclosed is the revised application together with the formal documents. Please execute the documents where indicated and forward same to the other inventors and fax to me at 561-653-5333. Thank you.

PLEASE CALL (813) 223-7333, EXT. 5210 IMMEDIATELY
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EXHIBIT 4

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Equitrac User ID:

FAX: 615-7005

PLEASE DELIVER THE ACCOMPANYING TELECOPIED MATERIAL TO:	**TRANSMITTAL DATE:** Feb 15, 2001
NAME: David Reich	**CLIENT/MATTER NO:** 6169-143
PHONE:	**TOTAL PAGES:** 41
FIRM/COMPANY NAME:	**CITY, STATE:**

SENDER'S NAME: Kevin Cuenot

Comments from Sender:

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WEST PALM BEACH, FLORIDA 33401
PHONE (561) 653-5000 • FAX (561) 653-5333
http://www.akerman.com

February 22, 2001

VIA CERTIFIED MAIL -
RETURN RECEIPT REQUESTED

Mr. Ji Wee Tan
138 Heritage Way
West Palm Beach, FL 33407

Re: New Patent Application
METHOD AND APPARATUS FOR REFORMATTING FORMATTED CONTENT
Our Ref: 6169-143

Dear Mr. Tan:

Enclosed please find a copy of the above-referenced patent application together with the Declaration and Power of Attorney, Assignment and Oath & Assignment documents. Please review the application and, if acceptable, sign the formal documents where indicated and return them to me for filing with the application.

Please feel free to contact me if you should have any questions or comments.

Sincerely,

AKERMAN SENTERFITT

Steven M. Greenberg

SMG/kmw
Enclosures

EXHIBIT 5

P1007930;1

AKERMAN SENTERFITT

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222 LAKEVIEW AVENUE, SUITE 400
WEST PALM BEACH, FLORIDA 33401
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http://www.akerman.com

February 27, 2001

Mr. Ji Wee Tan
3333 South Congress Avenue
Suite 403
Delray Beach, FL 33445

Re: New Patent Application
METHOD AND APPARATUS FOR REPURPOSING FORMATTED CONTENT
Our Ref: 6169-143

Dear Mr. Tan:

Enclosed please find a copy of the above-referenced patent application together with the Declaration and Power of Attorney, Assignment and Oath & Assignment documents. Please review the application and, if acceptable, sign the formal documents where indicated and return them to me for filing with the application.

Please feel free to contact me if you should have any questions or comments.

Sincerely,

AKERMAN SENTERFITT

Steven M. Greenberg

SMG/kmw
Enclosures

EXHIBIT 6

P1007930;1